

REMARKS/ARGUMENTS

Claims 1-20 are pending in the application. Claims 1, 2, 8, 9 and 15 are independent claims. Under 37 C.F.R. 1.83(a), the Examiner objected to the drawings. Under 35 U.S.C. § 112, the Examiner rejected claims 1-20 as being indefinite. Under 35 U.S.C. § 102(e), the Examiner rejected claim 1 as anticipated by U.S. Patent No. 6,208,988 issued to Schultz (hereinafter "Schultz"), and rejected claims 2 and 3 as anticipated by U.S. Patent No. 6,385,619 issued to Eichstaedt *et al.* (hereinafter "Eichstaedt"). The Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt in view of U.S. Patent No. 5,557,227 issued to Cook (hereinafter "Cook"). The Examiner rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt in view of U.S. Patent No. 5,557,227 issued to Heckerman (hereinafter "Heckerman"). The Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of U.S. Patent No. 6,473,755 issued to Evans (hereinafter "Evans"). Finally, the Examiner has rejected claims 9-20 "for the reasons given above [for the correspondingly rejected claims 1-8]."

A. Objections to the Drawings

The Examiner objected to the drawings and suggested that certain additional figures be added (i.e., a flow chart of the process) and that Figs. 2 and 3 be amended (i.e., differentiating between the two graph lines, providing an explanation of the variables k and r , and adding a title).

In accordance with the Examiner's suggestions, additional figures providing flow charts of the processes described in the specification have been added. In particular, new Fig. 4 provides a flow chart to illustrate a method of one embodiment of the present invention for deriving a normalized score and new Fig. 5 provides a flow chart to illustrate a method of another embodiment for deriving a normalized score for a collection of profiles. In addition,

titles indicating that Figs. 2 and 3 show mappings for delivery ratio thresholds have been added and references numbers differentiating the graph lines have been amended to match the numbers in the specification. Moreover, the variables k and r are described in the specification.

Applicant, therefore, respectfully submits that the objections to the drawings be removed because new figures were added and existing figures were amended in accordance with the Examiner's suggestions.

B. The Claims Satisfy 35 U.S.C. § 112 Because They Particularly Point Out And Distinctly Claim The Subject Matter That Applicant Regards As The Invention

The Examiner rejected claims 1-20 as failing to satisfy 35 U.S.C. § 112 because he felt that essential elements were missing from claim 1 because it did not contain definitions of “analyzing” and “comparing results” and because it did not specify its relationship to claim 2. But the Examiner has not cited any legal authority indicating that a claim is required to include definitions of its terms in order to satisfy 35 U.S.C. § 112. Indeed, the Federal Circuit has stated otherwise by clearly explaining that claim terms — particularly common phrases like “analyzing” and “comparing results” — may be construed according to their plain and ordinary meaning.¹ In addition, the Examiner has not cited any legal authority indicating that an independent claim (such as claim 1) needs to specify its relation to another independent claim (such as claim 2) in order to satisfy 35 U.S.C. § 112. Indeed, 35 U.S.C. § 112 requires only that the claims particularly point out and distinctly claim the subject matter that applicant regards as the invention. Because the claims do so, Applicant respectfully submits that this rejection be withdrawn.

¹ See e.g., *Lantech, Inc. v. Keip Machine Co.*, 32 F.3d 542, 31 USPQ2d 1666 (Fed. Cir. 1994) (construing a claim term in accordance with its ordinary meaning because it was not highly technical).

C. The Claims Are Not Anticipated Under 35 U.S.C. § 102(e)

The Examiner rejected claim 1 under 35 U.S.C. § 102(e) because he felt that — according to his interpretation of that claim — it is anticipated by Schultz. In particular, according to the Examiner’s interpretation, “the comparison to a resource involves comparing the topic to the data stream as a whole, and then to the selected resource, and the selected document is the resource that closely matches the data stream in relation to the topic.”² But that is not what claim 1 recites. Rather, claim 1 recites a method of selecting documents from a data stream, comprising: selecting a resource having information comparable to said data stream; selecting at least one topic; analyzing said topic against said resource; analyzing said topic against said data stream; and comparing results from said data stream analysis to results from said resource analysis to select a document from said data stream. In other words, the claim terms: “data stream,” “resource,” and “selected items” — when properly construed — are three separate items while under the Examiner’s incorrect construction, they constitute only two items. Because the Examiner’s rejection of claim 1 based on Schultz results from a misunderstanding of that claim and because one or more elements of claim 1 (when properly construed) are wholly absent from Schultz as explained in the Applicant’s previous amendment, Applicant respectfully submits that this rejection be withdrawn.

The Examiner rejected independent claim 2 under 35 U.S.C. § 102(e) as being anticipated by Eichstaedt because he felt that “there is no mention in the claims ... that the same profile must be used in two separate analyses” and therefore, that claim 2 does not distinguish over Eichstaedt.³ But the use of the qualifier “said” immediately preceding each and every occurrence of the term “profile” after its first occurrence in claim 2 does indeed indicate that the

² Office Action at pg. 2.

same profile must be used in two separate analysis: 1) for analyzing a reference corpus of documents and 2) for scoring at least one document. And the Examiner does not dispute that the use of the same profile for both of these analyses is not disclosed in Eichstaedt. Because the Examiner's rejection of claim 2 based on Eichstaedt results from an incorrect construction of that claim and because one or more elements of claim 2 (when properly construed) are wholly absent from Eichstaedt as explained above and in the Applicant's previous amendment, Applicant respectfully submits that this rejection be withdrawn.

The Examiner also rejected claim 3, which depends from claim 1 under 35 U.S.C. § 102(e) as being anticipated by Eichstaedt. But claim 3 is patentable not only by virtue of its dependency from a base claim that is patentable (claim 2), but also for the totality of features recited within it. For this reason and all the reasons expressed in Applicant's previous amendment, Applicant respectfully submits that this rejection be withdrawn.

D. The Claims Are Not Obvious Under 35 U.S.C. § 103(a)

The Examiner rejected independent claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Evans. But according to the Examiner himself, "[c]laim 8 is drawn to many of the limitations of claim 1."⁴ And as explained above, one or more of these limitations are wholly absent from Schultz. Further, the Examiner does not contend that Evans discloses all the limitations that are missing from Schultz. For these reasons and all the other reasons expressed in Applicant's previous amendment, Applicant respectfully submits that this rejection be withdrawn.

³ Examiner's Office Action at page 4.

⁴ Office Action at page 10.

The Examiner has rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt in view of Cook. The Examiner has further rejected claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Eichstaedt in view of Heckerman. Dependent claims 4, 5, 6, and 7, however, are patentable not only by virtue of their dependency from base claims that are patentable, but also for the totality of features recited within them. For these reasons and all the reasons expressed in Applicant's previous amendment, Applicant respectfully submits that these rejections also be withdrawn.

E. The Remaining Claims Are Also Patentable

All other pending claims—claims 9-20—according to the Examiner "do not teach or define above the correspondingly rejected claims 1-8 and thus claims 9-20 are rejected for the reasons given above."⁵ Claims 1-8 have been shown above to be patentable. Thus, the other pending claims are also patentable.

⁵ Office Action, p. 11.

II. Conclusion

The Examiner's rejections of the claims appear to have resulted from the absence and /or incompleteness of the drawings and from a misunderstanding of the claim language. Applicant has added new figures and amended the existing figures in accordance with the Examiner's suggestions and has clarified the Examiner's misunderstanding. For these reasons and all the other reasons expressed herein and in Applicant's previous amendment, Applicant respectfully submits that the pending claims — when properly construed — satisfy 35 U.S.C. § 112 and are patentable over the prior art cited by the Examiner.

Respectfully submitted,

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